

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BOARD OF PATENT APPEALS AND INTERFERENCES**

<p>App. Ser. No.: 10/622,876 Appellant(s): Shintani et al. Filing Date: July 18, 2003 Title: Electronic Program Guide Feature for AV System Examiner: Son P. Huynh Art Unit: 2424 Customer No.: 22242 Confirm. No.: 2767 Attorney Docket No.: 81131 7114</p>	<p style="text-align: center;"><b>Certificate of Transmission/Mailing/Express Mailing</b></p> <p>Facsimile Transmission number: (571) 273-8300; or, if applicable, "Express Mail" mailing label number: _____</p> <p>I hereby certify that this correspondence is being facsimile transmitted to the USPTO, under 37 C.F.R. § 1.8, electronically transmitted via the USPTO electronic filing system, under 37 C.F.R. § 1.6(a)(4), deposited with the United States Postal Service with sufficient postage as first class mail in an envelope, under 37 C.F.R. § 1.8, or deposited with the United States Postal Service as "Express Mail Post Office to Addressee" service, under 37 C.F.R. § 1.10, on the below indicated date and is addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.</p> <p>Typed/Printed Name of Person Transmitting, Mailing, or Express-Mailing Correspondence: <u>May Lin DeHaan</u></p> <p>Signature: <u>May Lin DeHaan</u></p> <p>Date of Transmission/Deposit: <u>April 17, 2009</u></p>
--	---

**Mail Stop: Appeal Brief - Patents**  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, VA 22313-1450**

**REPLY BRIEF**  
**UNDER 37 C.F.R. § 41.41**

To the Board:

This document is a Reply Brief to the Examiner's Answer, dated February 19, 2009, under 37 C.F.R. § 41.41. The Examiner has not raised new grounds for rejection in the Answer; and, hence, the subject matter of the January 9, 2009, Appeal Brief remains relevant and without need for supplementation. The Examiner has, however, made particular points which may constitute new arguments that may be suitably addressed in the Reply Brief. The Appellants respectfully represent that this Reply Brief does not include any new, or non-admitted, Amendment, Affidavit, or other evidence. This Reply Brief contains only responses to the specific points as were raised by the Examiner in the Answer. Thus, the Board is referred to the January 9, 2009, Appeal Brief for the Appellants' case in chief.

## **TABLE OF CONTENTS**

### **SECTION**

I.	Table of Authorities.....	3
II.	Statement of Additional Facts .....	6
III.	Argument .....	7

## **I. TABLE OF AUTHORITIES**

### **A. Statutes**

35 U.S.C. 103(a)

### **B. Rules**

1. 37 C.F.R § 1.75(d)(1)

### **C. Regulations**

1. MPEP § 2111
2. MPEP § 2111.01
3. MPEP § 2173.05(a)
4. MPEP § 2181 - § 2186

### **D. Case Law**

1. *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005)
2. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004)
3. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000)
4. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)
5. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)

6. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)
7. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004)
8. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)
9. *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004)
10. *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004)
11. *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004)
12. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 Fed. Cir. 2003)
13. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003)
14. *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994)
15. *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983)
16. *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976))
17. *In re Weiss*, 989 F.2d 1202, 26 USPQ2d 1885 (Fed. Cir. 1993)
18. *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003)

19. *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)
20. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003)
21. *ACTV, Inc. v. The Walt Disney Company*, 346 F.3d 1082, 1092, 68 USPQ2d 1516, 1524 (Fed. Cir. 2003)
22. *E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003)
23. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998)
24. *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996)
25. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 Fed. Cir. 2001)
26. *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999)
27. *MSM Investments Co. v. Carolwood Corp.*, 259 F.3d 1335, 1339-40, 59 USPQ2d 1856, 1859-60 (Fed. Cir. 2001)
28. *Rapoport v. Dement*, 254 F.3d 1053, 1059-60, 59 USPQ2d 1215, 1219-20 (Fed. Cir. 2001)
29. *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994)
30. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992)

31. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999)
32. *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998)
33. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999)
34. *Vitronics Corp. v. Conceptoronic Inc.*, 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996)
35. *Merck & Co., Inc., v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1370, 73 USPQ2d 1641, 1646 (Fed. Cir. 2005)

## **II. STATEMENT OF ADDITIONAL FACTS**

### **A. Conventional Definition or Plain Meaning of the Word “History”**

The conventional definition or plain meaning of the word “history” is as follows: “A narrative of events; a story.”<sup>1</sup>

### **B. Conventional Definition or Plain Meaning of the Word “Information”**

The conventional definition or plain meaning of the word “information” is as follows: “Knowledge of a specific event or situation ....”<sup>2</sup>

### **C. Conventional Definition or Plain Meaning of the Phrase “History Information”**

The conventional definition or plain meaning of the phrase “history information” is as follows: “Knowledge of a specific event or situation”<sup>3</sup> from “[a] narrative of events; a story.”<sup>4</sup>

---

<sup>1</sup> The American Heritage Dictionary of the English Language, 3<sup>rd</sup> Ed., p. 857, Houghton Mifflin Company (1992).

<sup>2</sup> *Id.* at 927.

<sup>3</sup> *Id.*

<sup>4</sup> *Id.* at 857.

### III. ARGUMENT

#### A. Whether Claims 1, 3, and 4 are unpatentable, under 35 U.S.C. § 103(a), over Miller et al. (U.S. Patent No. 5,585,866), in view of Kerman et al. (U.S. Patent No. 5,659,366)

##### 1. Specific Nature of the Rejection as to Issue A

In the Answer, the Examiner cites Miller et al. (col. 14, l. 41 - col. 15, l. 13) to assert that “the claimed ‘history information’ is interpreted as ‘previously set’ information/data or data or *reminders* previously set by the user” (March 6, 2008, Office Action, p. 3, ll. 3-4) and cites MPEP § 2111 to interpret the limitations against Claim 1. Claims 3 and 4 subsume the limitations of Claim 1 by dependency. The Appellants respectfully submit that the Examiner still mischaracterizes the terms “history” and “information” as well as the phrase “history information.” The Appellants respectfully maintain their traversal of these grounds for rejection on this basis. The Appellants further submit that the claims construction at issue under this appeal involve plain meaning of the recited elements, rather than mere semantics.

##### 2. Relevant Rules as to Issue A

The relevant sections of the Manual of Patent Examination Procedure, citing relevant statutes, rules, and case law, are reproduced as follows:

#### **2111 Claim Interpretation; Broadest Reasonable Interpretation [R-5] CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION**

During patent examination, the pending claims must be “given their broadest reasonable interpretation **consistent with the specification**.” The Federal Circuit’s *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the “broadest reasonable interpretation” standard:

The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Cir.*, 367 F.3d 1359, 1364 [ 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR



1.75(d)(1).415 F.3d at 1316, 75 USPQ2d at 1329. See also *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (Claim 9 was directed to a process of analyzing data generated by mass spectrographic analysis of a gas. The process comprised selecting the data to be analyzed by subjecting the data to a mathematical manipulation. The examiner made rejections under 35 U.S.C. 101 and 102. In the 35 U.S.C. 102 rejection, the examiner explained that the claim was anticipated by a mental process augmented by pencil and paper markings. The court agreed that the claim was not limited to using a machine to carry out the process since the claim did not explicitly set forth the machine. The court explained that “reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.”).

**The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.** *In re Corright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The Board’s construction of the claim limitation “restore hair growth” as requiring the hair to be returned to its original state was held to be an incorrect interpretation of the limitation. The court held that, consistent with applicant’s disclosure and the disclosure of three patents from analogous arts using the same phrase to require only some increase in hair growth, one of ordinary skill would construe “restore hair growth” to mean that the claimed method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair.). [Emphasis added]

#### 2111.01 Plain Meaning [R-5]

##### I. THE WORDS OF A CLAIM MUST BE GIVEN THEIR “PLAIN MEANING” UNLESS SUCH MEANING IS INCONSISTENT WITH THE SPECIFICATION

Although claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. **During examination, the claims must be interpreted as broadly as their terms reasonably allow.** *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) (The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation in light of the specification.). This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. Thus, “heating the resulting batter-coated dough to a temperature in the range of about 400°F to 850°F” required heating the dough, rather than the air inside an oven, to the specified temperature.). [Emphasis added]

##### II. IT IS IMPROPER TO IMPORT CLAIM LIMITATIONS FROM THE SPECIFICATION

**“Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”** *Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). See also *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004) (discussing recent cases wherein the court expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment); *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364,

1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) ("Interpretation of descriptive statements in a patent's written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment. The problem is to interpret claims 'in view of the specification' without unnecessarily importing limitations from the specification into the claims."); *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003) (Although the specification discussed only a single embodiment, the court held that it was improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order). See also paragraph IV., below. When an element is claimed using language falling under the scope of 35 U.S.C. 112, 6<sup>th</sup> paragraph (often broadly referred to as means or step plus function language), the specification must be consulted to determine the structure, material, or acts corresponding to the function recited in the claim. *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (see MPEP § 2181- § 2186).

In *In re Zletz*, *supra*, the examiner and the Board had interpreted claims reading "normally solid polypropylene" and "normally solid polypropylene having a crystalline polypropylene content" as being limited to "normally solid linear high homopolymers of propylene which have a crystalline polypropylene content." The court ruled that limitations, not present in the claims, were improperly imported from the specification. See also *In re Marast*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) ("Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'." 710 F.2d at 802, 218 USPQ at 292 (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original). The court looked to the specification to construe "essentially free of alkali metal" as including unavoidable levels of impurities but no more.). Compare *In re Weiss*, 989 F.2d 1202, 26 USPQ2d 1885 (Fed. Cir. 1993) (unpublished decision - cannot be cited as precedent) (The claim related to an athletic shoe with cleats that "break away at a preselected level of force" and thus prevent injury to the wearer. The examiner rejected the claims over prior art teaching athletic shoes with cleats not intended to break off and rationalized that the cleats would break away given a high enough force. The court reversed the rejection stating that when interpreting a claim term which is ambiguous, such as "a preselected level of force", we must look to the specification for the meaning ascribed to that term by the inventor." The specification had defined "preselected level of force" as that level of force at which the breaking away will prevent injury to the wearer during athletic exertion.) [Emphasis added]

**III. "PLAIN MEANING" REFERS TO THE ORDINARY AND CUSTOMARY MEANING GIVEN TO THE TERM BY THOSE OF ORDINARY SKILL IN THE ART**

"[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (*en banc*). *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003) ("In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art."). It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003) (Dictionary definitions were used to determine the ordinary and customary meaning of the words "normal" and "predetermine" to those skilled in the art. In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the inventor.); *ACTV, Inc. v. The Walt Disney Company*, 346 F.3d 1082, 1092, 68 USPQ2d 1516, 1524 (Fed. Cir. 2003) (Since there was no express definition given for the term "URL" in the specification, the term should be given its broadest reasonable interpretation consistent with the intrinsic record and take on the ordinary and customary meaning attributed to it by those of ordinary skill in the art; thus, the term "URL" was held to encompass both relative and absolute URLs.); and *E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003) (Where no explicit definition for the term "electronic multi-function card" was given in the specification, this term should be given its ordinary meaning and broadest reasonable interpretation; the term should not be limited to the industry standard definition of credit card where there is no suggestion that this definition applies to the electronic multi-function card as claimed, and should not be limited to preferred embodiments in the specification.).

**The ordinary and customary meaning of a term may be evidenced by a variety of sources, including “the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.”** *Phillips v. AWH Corp.*, 415 F.3d at 1314, 75 USPQ2d at 1327. If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant’s use of the terms. *Brookhill-Wilk I*, 334 F.3d at 1300, 67 USPQ2d at 1137; see also *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) (“Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.”) and *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996) (construing the term “solder reflow temperature” to mean “peak reflow temperature” of solder rather than the “liquidus temperature” of solder in order to remain consistent with the specification.). If more than one extrinsic definition is consistent with the use of the words in the intrinsic record, the claim terms may be construed to encompass all consistent meanings. See e.g., *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (explaining the court’s analytical process for determining the meaning of disputed claim terms); *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999) (“[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning.”). Compare *MSM Investments Co. v. Carolwood Corp.*, 259 F.3d 1335, 1339-40, 59 USPQ2d 1856, 1859-60 (Fed. Cir. 2001) (Claims directed to a method of feeding an animal a beneficial amount of methylsulfonylmethane (MSM) to enhance the animal’s diet were held anticipated by prior oral administration of MSM to human patients to relieve pain. Although the ordinary meaning of “feeding” is limited to provision of food or nourishment, the broad definition of “food” in the written description warranted finding that the claimed method encompasses the use of MSM for both nutritional and pharmacological purposes.); and *Rapoport v. Dement*, 254 F.3d 1053, 1059-60, 59 USPQ2d 1215, 1219-20 (Fed. Cir. 2001) (Both intrinsic evidence and the plain meaning of the term “method for treatment of sleep apneas” supported construction of the term as being limited to treatment of the underlying sleep apnea disorder itself, and not encompassing treatment of anxiety and other secondary symptoms related to sleep apnea.). [Emphasis added]

#### IV. APPLICANT MAY BE OWN LEXICOGRAPHER

An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” and, if done, must “set out his uncommon definition in some manner within the patent disclosure” so as to give one of ordinary skill in the art notice of the change” in meaning) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992)). Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings”). Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also *Process Control Corp. v. Hydrexclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) and MPEP § 2173.05(a). **The specification should also be relied on for more than just explicit lexicography or clear disavowal of claim scope to determine the meaning of a claim term when applicant acts as his or her own lexicographer; the meaning of a particular claim term may be defined by implication, that is, according to the usage of the term in the context in the specification.** See *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*); and *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996). Compare *Merck & Co., Inc. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1370, 73 USPQ2d 1641, 1646 (Fed. Cir. 2005), where the court held that patentee failed to redefine the ordinary meaning of “about” to mean “exactly” in clear enough terms to justify the counterintuitive definition of “about.” (“When a patentee acts as his own lexicographer in redefining the meaning of particular claim terms away from their ordinary meaning, he must clearly express that intent in the written description.”). [Emphasis added.]

### 3. Analysis of the Relevant Rules as Applied to the Facts in Relation to Issue A

Although the Examiner has correctly stated the rule as set forth in MPEP § 2111, the Appellants respectfully submit that the Examiner has misapplied the rule to the facts of the case in stating, "The 'history information' could [include] other information such as channel information, title, time, etc, include in a 'reminder' ..." (Examiner's Answer, p. 10, second paragraph), and in stating, "The claimed 'history information' is interpreted as 'previously set' information/data or data of reminders previously set by the user" (Examiner's Answer, p. 11, first paragraph).

The Appellants respectfully submit that the Examiner has failed to fully appreciate the distinction between "history information" and all other "information" in the present invention system, because the Examiner has misinterpreted "history information" to include all other "information" of the claimed system, even though the Specification makes a clear distinction between these two types of information. As a threshold matter, MPEP § 2111 provides: "During patent examination, the pending claims must be 'given their **broadest reasonable interpretation consistent with the specification.**'" [Emphasis added.]

In the originally filed application, "history information" is defined as follows: "a **description of the program**" (Specification, p. 2, l. 23; p. 3, ll. 25-26), "the **history information** for a **previous episode**" (Specification, p. 2, ll. 29-30; p. 3, l. 33), "**history information** includes a **description of the particular episode**" (Specification, p. 4, ll. 24-25), "**history information** for the **previous episodes** of programs ... a **brief description of the plot**, actors, theme, ..." (Specification, p. 8, ll. 30-32), "the **history** might further **describe the general theme** of the program ... and further **describe the salient events which take place** in that particular episode" (Specification, p. 8, l. 33 – p. 9, l. 7), and "**history information** relating to the **previous episode** of the current program" (Specification, p. 10, ll. 22-23).

In contrast to "history information," the originally filed application defines other "information," i.e., without any modifying words, as follows: "any data that the system has

stored regarding the user's set-up information," e.g., user presets (Specification, p. 7, ll. 19-20). The originally filed application further discloses: **"Most of the information stored in the RAM 208 is referred to herein as program history information ..."** [Emphasis added.] (Specification, p. 8, ll. 10-11). As such, **not all** of the **"information"** is **"history information"** as defined by the Specification. "History information" has been extremely particularly defined, even by the Specification. The rest of the information in the present invention is what may include user presets, etc. **As such "history information" is a separate element from other "information" in the present application.** The Examiner has inadvertently engaged in grouping "apples" with "oranges," i.e., "history information" with other "information." Nowhere in the Specification can be found the interpretation proffered by the Examiner, because "reminders" and "user presets" are never mentioned anywhere in the Specification in connection with the phrase "history information."

Further, MPEP § 2111.01 provides: "The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation in light of the specification. .... This means that **the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. .... Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. .... In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context,** and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the inventor." [Emphasis added.]

As discussed, *supra*, in the section entitled "Statement of Additional Facts," the conventional definition or plain meaning of the word "history" is as follows: "A narrative of events; a story."<sup>5</sup> The conventional definition or plain meaning of the word "information" is as follows: "Knowledge of a specific event or situation ...."<sup>6</sup> As such, the conventional definition

---

<sup>5</sup> *Id.* at 857.

<sup>6</sup> *Id.* at 927.

or plain meaning of the phrase “history information” is as follows: “Knowledge of a specific event or situation”<sup>7</sup> from “[a] narrative of events; a story.”<sup>8</sup> Thus, even in applying the “plain meaning” rule to claim construction, the Examiner has made a great leap of the imagination by including “reminders” and “user presets” in “a narrative of events.” While “reminders” and “user presets” may be “data” or other “information,” they cannot be reasonably construed as “history information” by any basic dictionary definition or plain meaning.

In addition, the Appellants have not used the phrase “history information” in any manner that is inconsistent with the foregoing dictionary definition or plain meaning, because the presently claimed “history information” has been described as follows by the Appellants in the original Specification itself: “a **description of the program**” (Specification, p. 2, l. 23; p. 3, ll. 25-26), “the history information for a **previous episode**” (Specification, p. 2, ll. 29-30; p. 3, l. 33), “**history information** includes a **description of the particular episode**” (Specification, p. 4, ll. 24-25), “**history information** for the **previous episodes** of programs ... a **brief description of the plot**, actors, theme, ...” (Specification, p. 8, ll. 30-32), “the **history** might further describe the **general theme** of the program ... and further describe the **salient events which take place** in that **particular episode**” (Specification, p. 8, l. 33 – p. 9, l. 7), and “**history information** relating to the **previous episode** of the current program” (Specification, p. 10, ll. 22-23), as discussed, *supra*.

#### 4. Conclusion as to Issue A

Accordingly, independent Claim 1 positively recites the limitation “history information.” As such, Claims 3 and 4 subsume this limitation by dependency. Thus, the Appellants respectfully submit that Claims 1, 3, and 4, which encompass the limitation “history information,” are not taught, suggested, motivated, or otherwise obviated by the cited art and that finality of the March 6, 2008, Office Action is in clear error. Therefore, the Appellants respectfully request that the grounds for rejection on this basis are reversed and that Claims 1, 3, and 4 are passed to allowance in due course.

---

<sup>7</sup> *Id.*

<sup>8</sup> *Id.* at 857.

**B. Whether Claim 5 is unpatentable, under 35 U.S.C. § 103(a), over Miller et al. (U.S. Patent No. 5,585,866), in view of Kerman et al. (U.S. Patent No. 5,659,366), and in further view of Ozkan et al. (U.S. Patent No. 7,032,236)**

**1. Specific Nature of the Rejection as to Issue B**

In the Answer, the Examiner cites Ozkan as follows: “Ozkan is relied on for the teaching of EPG program information is in the digital signal’s PSIP (... col. 3, ll. 23-20[?])” and “Ozkan also discloses digital video signal (... col. 3, ll. 43-60; col. 3, ll. 16-33)” to assert the obviousness rejection of Claim 5. However, as discussed, *supra*, the Examiner has also asserted, in the Answer, that “the claimed ‘history information’ is interpreted as ‘previously set’ information/data or data or *reminders* previously set by the user” (March 6, 2008, Office Action, p. 3, ll. 3-4) and cites MPEP § 2111 to interpret the limitations against Claim 1. Claim 5 subsumes the limitations of Claim 1 by dependency. The Appellants respectfully resubmit that the Examiner still mischaracterizes the term “information” and the phrase “history information” in the rejection of Claim 5. The Appellants respectfully maintain their traversal of these grounds for rejection on this basis. The Appellants further submit that the claims construction at issue under this appeal involve plain meaning of the recited elements, rather than mere semantics.

**2. Relevant Rules as to Issue B**

The relevant sections of the Manual of Patent Examination Procedure, §§ 2111 and 2111.01, are reproduced, *supra*, and also apply to these grounds for rejection.

**3. Analysis of the Relevant Rules as Applied to the Facts in Relation to Issue B**

Reiterating, the Examiner has correctly stated the rule as set forth in MPEP § 2111, however, the Appellants respectfully submit that the Examiner has misapplied the rule to the facts of the case in stating, “The ‘history information’ could [include] other information such as channel information, title, time, etc, include in a ‘reminder’ ...” (Examiner’s Answer, p. 10,

second paragraph), and in stating, "The claimed 'history information' is interpreted as 'previously set' information/data or data of reminders previously set by the user" (Examiner's Answer, p. 11, first paragraph).

The Appellants respectfully resubmit that the Examiner has failed to fully appreciate the distinction between "history information" and all other "information" in the present invention system, because the Examiner has misinterpreted "history information" to include all other "information" of the claimed system, even though the Specification makes a clear distinction between these two types of information. As a threshold matter, MPEP § 2111 provides: "During patent examination, the pending claims must be 'given their **broadest reasonable interpretation consistent with the specification.**'" [Emphasis added]

In the originally filed application, "history information" is defined as follows: "a **description of the program**" (Specification, p. 2, l. 23; p. 3, ll. 25-26), "the **history information** for a **previous episode**" (Specification, p. 2, ll. 29-30; p. 3, l. 33), "**history information** includes a **description of the particular episode**" (Specification, p. 4, ll. 24-25), "**history information** for the **previous episodes** of programs ... a **brief description of the plot**, actors, theme, ..." (Specification, p. 8, ll. 30-32), "the **history** might further **describe the general theme** of the program ... and further **describe the salient events which take place in that particular episode**" (Specification, p. 8, l. 33 – p. 9, l. 7), and "**history information** relating to the **previous episode** of the current program" (Specification, p. 10, ll. 22-23).

In contrast to "history information," the originally filed application defines other "information," i.e., without any modifying words, as follows: "any data that the system has stored regarding the user's set-up information," e.g., user presets (Specification, p. 7, ll. 19-20). The originally filed application further discloses: "**Most** of the information stored in the RAM 208 is referred to herein as program history information ..." (Specification, p. 8, ll. 10-11). As such, **not all of the "information" is "history information"** as defined by the Specification. "History information" has been extremely particularly defined, even by the Specification. The rest of the information in the present invention is what may include user presets, etc. **As such, "history information" is a separate element from other "information" in the present**



**application.** The Examiner has inadvertently engaged in grouping “apples” with “oranges,” i.e., “history information” with other “information.” Nowhere in the Specification can be found the interpretation proffered by the Examiner, because “reminders” and “user presets” are never mentioned anywhere in the Specification in connection with the phrase “history information.”

Further, MPEP § 2111.01 provides: “The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation in light of the specification. .... This means that **the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification.** .... **Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say.** .... **In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context,** and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the inventor.” [Emphasis added.]

As discussed, *supra*, in the section, entitled “Statement of Additional Facts,” the conventional definition or plain meaning of the word “history” is as follows: “A narrative of events; a story.”<sup>9</sup> The conventional definition or plain meaning of the word “information” is as follows: “Knowledge of a specific event or situation ....”<sup>10</sup> As such, the conventional definition or plain meaning of the phrase “history information” is as follows: “Knowledge of a specific event or situation”<sup>11</sup> from “[a] narrative of events; a story.”<sup>12</sup> Thus, even in applying the “plain meaning” rule to claim construction, the Examiner has made a great leap of the imagination by including “reminders” and “user presets” in “a narrative of events.” While “reminders” and “user presets” may be “data” or other “information,” they cannot be reasonably construed as “history information” by any basic dictionary definition or plain meaning.

---

<sup>9</sup> *Id.* at 857.

<sup>10</sup> *Id.* at 927.

<sup>11</sup> *Id.*

<sup>12</sup> *Id.* at 857.

Furthermore, the Appellants have not used the phrase “history information” in any manner that is inconsistent with the foregoing dictionary definition or plain meaning, because the presently claimed “history information” has been described as follows by the Appellants in the original Specification itself: “a **description of the program**” (Specification, p. 2, l. 23; p. 3, ll. 25-26), “the **history information** for a **previous episode**” (Specification, p. 2, ll. 29-30; p. 3, l. 33), “**history information** includes a **description of the particular episode**” (Specification, p. 4, ll. 24-25), “**history information** for the **previous episodes** of programs ... a **brief description of the plot**, actors, theme, ...” (Specification, p. 8, ll. 30-32), “the **history** might further describe the **general theme** of the program ... and further describe the **salient events which take place** in that particular episode” (Specification, p. 8, l. 33 – p. 9, l. 7), and “**history information** relating to the **previous episode** of the current program” (Specification, p. 10, ll. 22-23), as discussed, *supra*.

#### 4. Conclusion as to Issue B

Accordingly, independent Claim 1 positively recites the limitation “history information.” As such, Claim 5 subsumes this limitation by dependency. Thus, the Appellants respectfully submit that Claim 5, which encompasses the limitation “history information,” is not taught, suggested, motivated, or otherwise obviated by the cited art and that finality of the March 6, 2008, Office Action is in clear error. Therefore, the Appellants respectfully request that the grounds for rejection on this basis are reversed and that Claim 5 is passed to allowance in due course.

C. **Whether Claims 2 and 6-8 are unpatentable, under 35 U.S.C. § 103(a), over Miller et al. (U.S. Patent No. 5,585,866), in view of Kerman et al. (U.S. Patent No. 5,659,366), and in further view of Ellis (U.S. Patent Application Publication No. 2003/0149988)**

## 1. Specific Nature of the Rejection as to Issue C

In the Answer, the Examiner asserts that "... the claim does not recite the selected episode is previously or already broadcast[,] but then concedes that "Claim 2 recites 'displaying the **history information** about the **selected episode** of the program **simultaneously with another episode** of the program, **wherein the selected episode** of the program **occurs previously to the another episode** of the program'" (Examiner's Answer, p. 14, third paragraph). The Appellants fail to see how the Examiner can reasonably make any distinction between "occurs previously" and "previously broadcast" in the context of the presently claimed system for audiovisual or television apparatuses.

As discussed, *supra*, in the Answer, the Examiner has interpreted "the claimed 'history information' as 'previously set' information/data or data or **reminders** previously set by the user" (March 6, 2008, Office Action, p. 3, ll. 3-4) and cites MPEP § 2111 to interpret the limitations against Claim 1. Claims 2, 6, and 8 subsume the limitations of Claim 1 by dependency. The Appellants respectfully resubmit that the Examiner still mischaracterizes the terms "information" and "history information." The Appellants respectfully maintain their traversal of these grounds for rejection on this basis. The Appellants further submit that the claims construction at issue under this appeal involve plain meaning of the recited elements, rather than mere semantics.

## 2. Relevant Rules as to Issue C

The relevant sections of the Manual of Patent Examination Procedure, §§ 2111 and 2111.01, are reproduced, *supra*, and also apply to these grounds for rejection.

## 3. Analysis of the Relevant Rules as Applied to the Facts in Relation to Issue C

Reiterating, the Examiner has correctly stated the rule as set forth in MPEP § 2111, however, the Appellants respectfully submit that the Examiner has misapplied the rule to the

facts of the case in stating, “The ‘history information’ could [include] other information such as channel information, title, time, etc, include in a ‘reminder’ ...” (Examiner’s Answer, p. 10, second paragraph), and in stating, “The claimed ‘history information’ is interpreted as ‘previously set’ information/data or data of reminders previously set by the user” (Examiner’s Answer, p. 11, first paragraph).

The Appellants respectfully resubmit that the Examiner has failed to fully appreciate the distinction between “history information” and all other “information” in the present invention system, because the Examiner has misinterpreted “history information” to include all other “information” of the claimed system even though the Specification makes a clear distinction between these two types of information. As a threshold matter, MPEP § 2111 provides: “During patent examination, the pending claims must be ‘given their **broadest reasonable interpretation consistent with the specification.**’” [Emphasis added.]

In the originally filed application, “**history information**” is defined as follows: “a **description of the program**” (Specification, p. 2, l. 23; p. 3, ll. 25-26), “the **history information** for a **previous episode**” (Specification, p. 2, ll. 29-30; p. 3, l. 33), “**history information** includes a **description of the particular episode**” (Specification, p. 4, ll. 24-25), “**history information** for the **previous episodes** of programs ... a **brief description of the plot**, actors, theme, ...” (Specification, p. 8, ll. 30-32), “the **history** might further **describe the general theme** of the program ... and further **describe the salient events which take place** in that particular episode” (Specification, p. 8, l. 33 – p. 9, l. 7), and “history information relating to the **previous episode** of the current program” (Specification, p. 10, ll. 22-23).

In contrast to “history information,” the originally filed application defines other “information,” i.e., without any modifying words, as follows: “any data that the system has stored regarding the user’s set-up information,” e.g., user presets (Specification, p. 7, ll. 19-20). The originally filed application further discloses: “**Most of the information** stored in the RAM 208 is referred to herein as program **history information** ...” (Specification, p. 8, ll. 10-11). As such, **not all** of the “**information**” is “**history information**” as defined by the Specification. “History information” has been extremely particularly defined, even by the Specification. The

rest of the information in the present invention is what may include user presets, etc. **As such, “history information” is a separate element from other “information” in the present application.** The Examiner has inadvertently engaged in grouping “apples” with “oranges,” i.e., “history information” with other “information.” Nowhere in the Specification can be found the interpretation proffered by the Examiner, because “reminders” and “user presets” are never mentioned anywhere in the Specification in connection with the phrase “history information.”

Further, MPEP § 2111.01 provides: “The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation in light of the specification. .... This means that **the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification.** .... **Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say.** .... **In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context,** and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the inventor.” [Emphasis added]

As discussed, *supra*, in the section, entitled “Statement of Additional Facts,” the conventional definition or plain meaning of the word “history” is as follows: “A narrative of events; a story.”<sup>13</sup> The conventional definition or plain meaning of the word “information” is as follows: “Knowledge of a specific event or situation ....”<sup>14</sup> As such, the conventional definition or plain meaning of the phrase “history information” is as follows: “Knowledge of a specific event or situation”<sup>15</sup> from “[a] narrative of events; a story.”<sup>16</sup> Thus, even in applying the “plain meaning” rule to claim construction, the Examiner has made a great leap of the imagination by including “reminders” and “user presets” in “a narrative of events.” While “reminders” and “user presets” may be “data” or other “information,” they cannot be reasonably construed as

---

<sup>13</sup> *Id.* at 857.

<sup>14</sup> *Id.* at 927.

<sup>15</sup> *Id.*

<sup>16</sup> *Id.* at 857.

“history information” by basic dictionary definition.

In addition, the Appellants have not used the phrase “history information” in any manner that is inconsistent with the foregoing dictionary definition or plain meaning, because the presently claimed “history information” has been described as follows by the Appellants in the original Specification itself: “a **description of the program**” (Specification, p. 2, l. 23; p. 3, ll. 25-26), “the **history information** for a **previous episode**” (Specification, p. 2, ll. 29-30; p. 3, l. 33), “**history information** includes a **description of the particular episode**” (Specification, p. 4, ll. 24-25), “**history information** for the **previous episodes** of programs ... a **brief description of the plot**, actors, theme, ...” (Specification, p. 8, ll. 30-32), “the **history** might further **describe the general theme** of the program ... and further **describe the salient events which take place** in that particular episode” (Specification, p. 8, l. 33 – p. 9, l. 7), and “**history information** relating to the **previous episode** of the current program” (Specification, p. 10, ll. 22-23), as discussed, *supra*.

#### 4. Conclusion as to Issue C

Accordingly, independent Claim 1 positively recites the limitation “history information.” As such, Claims 2, 6, and 8 subsume this limitation by dependency. Thus, the Appellants respectfully submit that Claims 2, 6, and 8, which encompass the limitation “history information,” are not taught, suggested, motivated, or otherwise obviated by the cited art and that finality of the March 6, 2008, Office Action is in clear error. Therefore, the Appellants respectfully request that the grounds for rejection on this basis are reversed and that Claims 2, 6, and 8 are passed to allowance in due course.

#### D. CONCLUSION

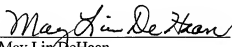
With the distinction between “information” and “history information” being appropriately observed, the Appellants respectfully submit that the contents of the January 9, 2009, Appeal Brief remain relevant and comprise a compelling showing of patentability. The Appellants believe that the comments set forth herein regarding the Examiner’s Answer for

Claim 1 represent the same or similar reasoning as should be applied to the remaining positions taken in the Answer. For the sake of brevity, the Appellants have avoided repetitive analysis here for each such position. Accordingly, the Appellants respectfully submit that Claims 1-8, as contained in Appendix "A" (Claims Appendix) of the January 9, 2009, Appeal Brief, are believed to be patentably distinct over the cited references.

Thus, reconsideration of the present application, in light of the foregoing argument and the statement of additional facts herein presented, is respectfully requested. Therefore, Claims 1-8, as amended on December 10, 2007, are believed to be fully supported by the originally filed specification and are believed to be in allowable form. In view of the foregoing arguments, the Appellants respectfully request that the rejections of the pending claims are REVERSED and that Claims 1-8 are passed to allowance in due course. In the event that any additional fees become due or payable, the Examiner is authorized to charge USPTO Deposit Account No. 06-1135 accordingly.

Respectfully submitted,

Dated: 4/16/2009

  
May Lin DeHaan  
Reg. No. 42,472  
Attorney for Appellant

Address all correspondence to:  
Thomas F. Lebens  
FITCH EVEN TABIN & FLANNERY, LLP  
120 South LaSalle  
Suite 1600  
Chicago, IL 60603

Direct telephone inquiries to:  
Thomas F. Lebens  
(805) 781-2865